IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Matthew A. Hayduk   Examiner: Melur Ramakrishnaiah

Serial No.:   09/955,510   Group Art Unit: 2614

Filed: September 18, 2001   Docket No.: 884.552US1

Title: APPLICATION EXECUTION METHOD AND APPARATUS

Customer Number: 21186

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

The Applicant requests review of the final rejection in the above-identified Application. No amendments are being filed with this Request, which is filed with a Notice of Appeal, and made for the reasons stated below.

§103 Rejection of the Claims

Claims 13-14 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich et al. (U.S. 6,542,812; hereinafter "Obradovich") in view of Jones (U.S. 6,411,891; hereinafter "Jones"). Claims 1-2, 4-5, 7-12, 16, 20-22, and 24-26 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila et al. (U.S. 6,549,625; hereinafter "Rautila") and Jones. Claim 15 was rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Jones and further in view of Rautila. Claims 18-19, 23, and 27 were rejected under 35 USC § 103(a) as being unpatentable over Obradovich in view of Rautila and Jones, and further in view of Masaki (EP 0883270 A1; hereinafter "Masaki").

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d (BNA) 1596, 1598 (Fed. Cir. 1988). However, no proper *prima facie* case of obviousness has been established because: (1) combining the references does not teach all of the limitations set forth in the claims, (2) there is no motivation to combine the references, and (3) combining the references provides no reasonable expectation of success. Thus, the

Applicant respectfully traverses the rejections for all of these reasons, and each of these points will be explained in detail, as follows.

Combining References Does Not Teach All Limitations: First, with respect to independent claims 1, 13, 16, 20, and 25, no combination suggested in the Office Action renders all of the claim limitations. As admitted by the Office, Obradovich does not disclose a mobile element having "a comparator module ... to compare the first and second service preferences" as part of the mobile element (claims 1 and 13), or downloading an application "when the second service preference is determined by the mobile element to be related to a first service preference stored in the mobile element" (claim 16), or "the application is downloaded to the mobile element upon the mobile element determining that the first service preference is related to the second service preference" (claims 20, 25) as claimed by the Applicant. Neither does Jones.

Jones uses a stationary personal computer 29 with proprietary software 223 to determine when a vehicle is approaching a specified location after receiving a message to that effect. *See* Jones, Col. 23, lines 44-53. User video display and audio playback preferences for receiving approach messages determine which of several display and playback options will be activated to inform the user of the vehicle's imminent arrival. *See* Jones, Col. 23, line 54 – Col. 24, line 9.

While the Office asserts that "Jones teaches a computer which can compare user preferences to provide required service ...", it is respectfully noted that nothing in Jones discloses a mobile unit that makes user preference comparisons. Rather, comparisons are conducted at a user's stationary computer that monitors mobile unit position. Thus, in Jones, user preferences included in the stationary computer are compared (using the proprietary software in the personal computer – not in the mobile unit) against myriad display and playback options, reducing them to some useful number, after an approaching vehicle message has been received by the stationary personal computer. *See Id.*

It is also respectfully noted that the result of the comparison has no effect on whether an application is downloaded. First, because no application is downloaded to the personal computer in Jones. And second, because it is only *after* a message is received that Jones' user preferences are noted by the software, not before. That is, the comparison made by the personal computer in Jones does nothing to affect what is received, unlike what is claimed by the Applicant.

The claims during examination should be interpreted as broadly as their terms reasonably allow. However, that interpretation must be tempered by the context in which the terms are used. The *Hyatt* court stated that "during examination proceedings, claims are given their broadest reasonable interpretation *consistent with the specification.*" *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2D (BNA) 1664, 1667 (Fed. Cir. 2000) (emphasis added). As is apparent from the explanation above, it is not reasonable or consistent to hold that Jones teaches the presence of a comparator module as claimed by the Applicant. Neither does Rautila or Masaki.

Rautila is similar to Jones, in that it relies on the user, rather than the mobile element, to determine which preferences will be selected. *See* Rautila, Col. 9, lines 34-43. Masaki does not match user preferences at all. Therefore, since no combination of the references provides all of the claimed elements, independent claims 1, 13, 16, 20, and 25 are nonobvious. This conclusion applies as well to all of the dependent claims, since any claim depending from a nonobvious independent claim is also nonobvious. See M.P.E.P. § 2143.03.

No Motivation to Combine References: The Office asserts that it would be obvious to "modify Obradovich's system to provide ... [a] comparator module ... to compare the first and second service preferences as this arrangement would facilitate to determine user preferences for further processing as taught by Jones, thus facilitating to implement user preferences." However, this assertion overlooks the fact that Jones does not teach a mobile unit comprising a comparator module. Rather, in Jones, comparisons are conducted outside of the mobile unit. In addition, no application is downloaded in response to the comparison. Thus, there is no motivation to add such comparisons to Obradovich, because comparisons according to Jones would continue occur *outside* of the mobile unit, while Obradovich maintains service preferences *inside* the mobile unit. In either case, no applications would be downloaded as a result.

The Office asserts that it would be obvious to combine Obradovich with Rautila because "this arrangement would provide ... application programs for the user to obtain information from servers ...". And Jones would be used to provide "a comparator module ...". However, these assertions are incorrect. Obradovich operates by sending user location GPS data to the server in order to provide the user with a useful route map. *See* Obradovich, Col. 8, lines 30-45. Rautila teaches away from using GPS data, since "not all mobile terminals will have GPS functionality" and "the position transceiver overcomes the location problem of the prior art by indicating and

transmitting its own very exact predefined position." Rautila, Col. 1, lines 39-47 and Col. 2, lines 24-27. It is evident that using the position position transceiver location of Rautila would not provide a useful route map to the user of Obradovich. Thus, there is no motivation to make this combination, as such would render the apparatus of Obradovich inoperative.

The addition of Jones does nothing to overcome the fact that Rautila teaches away from combination with Obradovich, and further, Jones does not account for the limitation of downloading an application into the *mobile unit* memory based on the comparison of preferences, as claimed by the Applicant in independent claims 1, 16, 20, and 25. Jones also teaches away from comparisons conducted inside the mobile unit, and therefore, provides no motivation for combination with Obradovich. Nothing taught by Masaki overcomes the fact that both Rautila and Jones teach away from the suggested combinations.

The test for obviousness under § 103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543, 551 (Fed. Cir. 1985). The fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. While the Office repeatedly characterizes the above arguments as being made "against references individually", this assertion ignores that fact that circumstances exist where the teachings of individual references must be considered - as is the case here, where Jones and Rautila both teach away from the combinations suggested.

Thus, it is respectfully noted that references must be considered in their entirety, including parts that teach away from the claims. *See* MPEP § 2141.02. Since Rautila and Jones both teach away from the claimed combination, there is no motivation to combine the references.

No Reasonable Expectation of Success: Modifying Obradovich to include the personal computer comparisons of Jones will not provide a mobile element having a comparator module to compare first and second service preferences. Modifying Obradovich to implement the application download capability of Rautila will not provide a mobile element capable of determining the existence of related preferences. Neither will combining Obradovich and Masaki.

Combinations of Obradovich and Jones provide no reasonable expectation of obtaining comparisons within the mobile element. Combinations using Obradovich and Rautila provide no reasonable expectation of determining the location of the mobile element, since Rautila disclaims this process, and one of ordinary skill in the art would not be led to make a combination which leads to an inoperative result.

Therefore, since there is no evidence in the record to support the disclosure by any combination of Obradovich, Jones, Rautila, or Masaki of a mobile element that compares preferences, so as to download applications based on the comparison, as claimed by the Applicant; since there is no motivation to supply the missing elements (because the references teach away from such a combination); and since no reasonable expectation of success arises, a *prima facie* case of obviousness has not been established with respect to independent claims 1, 13, 16, and 20, and 25, or any of the claims that depend from them. It is therefore respectfully requested that the rejection of claims 1-2, 4-5, 7-16, and 18-27 under 35 U.S.C. § 103(a) be reconsidered and withdrawn.

CONCLUSION

The Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone the Applicant's attorney at (210) 308-5677 to facilitate prosecution of this Application. If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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